

Attorney Docket: 112.P14193

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REMARKSStatus of the Claims

Claims 1-5, 7-11, 13 and 15-21 are pending in the above-referenced patent application. In this response, claim 1 has been amended, and no claims have been added or cancelled. Claim 1 was amended to more clearly delineate intended subject matter, and it is believed that these amendments do not narrow claim scope. Rather, in some circumstances, the claim scope may even be broadened. As a result, no prosecution history estoppel should result from these claim amendments.

Claim Rejection – 35 U.S.C. §112, first paragraph

In the Office Action, dated August 9, 2006, the Examiner rejected claims 9-11, 13 and 15 under 35 U.S.C 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

It is respectfully submitted that claims 9-11, 13 and 15 are adequately described by the specification and figures such that one skilled in the art would recognize that the inventor had possession of the claimed subject matter. Additionally, it is respectfully submitted that all limitations of the pending claims are supported by the originally filed specification and figures, and are adequately described by the specification and figures such as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention, in accordance with 35 USC 112, first paragraph. Although the claimed subject matter is not limited in this respect, examples of support for the limitation "a plurality of user-selectable compression ratios" may be found at least in paragraphs [0008] – [0009] and [0019], and Figure 2. The supporting portions of the specification are reproduced below with emphasis supplied:

[0008] It is another object of the present invention to provide a method of scanning applied on a scanner. A scanned object can be divided into various zones with various compression ratios set by users.

[0009] In the present invention, an apparatus for capturing a document with a plurality of

compression models comprises an image-processing system and an image-capturing system. The image-processing system is for accepting a request of setting the compression models for the document and processing the data of the document according to the compression models, wherein the request is from an exterior electric device connected to the apparatus. The image-capturing system is for capturing the data of the document, and is connected to the image-processing system and comprises multitudes of optic devices. The method for capturing the document with these compression models comprises accepting a request of setting the compression models for the document; capturing the data of the document; and processing the data of the document with these compression models.

[0019] FIG. 2 is a schematic diagram illustrating the flow chart in accordance with the present invention. First, pre-scanning of a document is performed by the scanner with default settings (step 20) in order to perform classification of the document. Users can view the pre-scanned image on a display screen with any image software in the host computer. Next, users would select a scanned zone for the document they want through the tools provided by the image software (step 22). As one of key features of the present invention, users can further determine one or more "Loss-less" zones and "Lossy" zones on the selected scanned zone (step 24). In the present invention, the geometric shapes of the "Loss-less" or "Lossy" zones can be arbitrary, dependent on the users and the tools provided by the image software. Then the formal scanning of the document is implemented by the scanner according to the users' settings through the host computer (step 26).

It is respectfully submitted that claims 9-11, 13 and 15 are adequately described by the specification and figures such as to reasonably convey to one skilled in the art that the inventor, at the time the invention was filed, had possession of the claimed subject matter, In accordance with 35 USC 112, first paragraph. Accordingly, it is respectfully requested that the Examiner withdraw this rejection of claims 1, 8, 9 and 12.

**Claim Rejections – 35 U.S.C §103(a)**

In the Office Action, the Examiner rejected claims 1-4, 5, 7-8 and 16-20 under 35 U.S.C 103(a) as being unpatentable over Matama (US Patent No. 6,700,685) in view of Barker et al. (US Patent No.

6,646,765, hereinafter "Barker"); rejected claims 9-11 and 13 under 35 U.S.C 103(a) as being unpatentable over Matama in view of Barker, and further in view of Suzuki et al. (US Patent No. 5,828,780, hereinafter "Suzuki"); and rejected claim 15 under 35 U.S.C 103(a) as being unpatentable over the combination of Matama, Barker and Suzuki, and further in view of Mikkelson et al. (US Patent No. 6,269,190, hereinafter "Mikkelson"). These rejections are respectfully traversed.

It is noted that in order to establish *prima facie* obviousness, there must be some suggestion or motivation to modify or combine reference teachings, and the modification or combination, if successful, must teach or suggest all of the claim limitations. As stated in the Manual for Patent Examining Procedure (MPEP), § 2142/2143, "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." It is respectfully submitted that the cited references do not meet these criteria. For example, the cited references, if successfully combined, would still not teach or suggest all the claim limitations.

As just an example, even if a successful combination of Matama and Barker were made, although assignee believes a successful combination could not be made, any resulting combination of Matama and Barker would still not show or describe at least "an image-processing component... adapted to receive a selection of a scanning zone of the preliminary scanned image, wherein the scanning zone comprises less than the entire preliminary scanned image, and further adapted to receive a selection of at least one sub-zone of the scanning zone and a selection of one of a plurality of compression models for the at least one sub-zone", as recited in claim 1.

Matama, directed toward dodging processing, is lacking at least one element of claim 1. For example, Matama does not teach or suggest receiving a selection of one of a plurality of compression models for the at least one sub-zone. In Matama, an operator designates a region of an image to apply

automatic dodging processing. There is no teaching or suggestion that a selection of one of a plurality of compression models of the designated region be applied, but, rather, dodging processing is automatically applied to the designated region. See, for example, col 8:42 – col 8:49. Matama does not employ a plurality of compression models, but, rather, the automatic dodging processing employs compression automatically when region is designated for automatic dodging processing. Also, Barker does not show or describe “an image-processing component... adapted to receive a selection of at least one sub-zone of the scanning zone and a selection of one of a plurality of compression models for the at least one sub-zone”, as recited in claim 1. Barker is directed toward scanning selected regions of a document, but does not teach or suggest receiving a selection of one of a plurality of compression models for the at least one sub-zone. Accordingly, Barker does not make up for the deficiencies of Matama in meeting at least the limitations “a selection of one of a plurality of compression models for the at least one sub-zone.”

Additionally, Examiner concedes that Matama includes at least one deficiency, in addition to the deficiency noted above. In the Office Action, page 3, Examiner states “Matama does not expressly disclose selection of a scanning zone of the preliminary scanned image, wherein the scanning zone comprises less than the entire preliminary scanned image”. It is respectfully submitted that Barker fails to cure at least the deficiency noted by the assignee, and, accordingly, any resulting combination of Matama and Barker would still not show or describe at least the limitations noted above. Accordingly, any resultant combination of Matama and Barker, if successful, although, as stated previously, Assignee does not accept that a successful combination of Matama and Barker could be made, would still not provide all the elements of the rejected claims, as set forth above. Accordingly, the Examiner has failed to make a successful prima facie showing of obviousness, and it is respectfully submitted that claims 1-4, 5, 7-8 and 16-20 are in a condition for allowance.

Additionally, it is respectfully submitted that claims 9-11 and 13 are not rendered obvious by the combination of Matama, Barker and Suzuki. For example, the cited references, if successfully combined, would still not teach or suggest all the claim limitations. As just an example, even if Matama, Barker and Suzuki were properly combined, although assignee believes that no such combination

would be proper, any resulting combination would still not show or describe at least "displaying a plurality of user-selectable sub-zones each having a plurality of user-selectable compression ratios". It is respectfully submitted that Suzuki does not cure this deficiency. Suzuki is directed toward color correction and reproduction, and does not show or describe at least "displaying a plurality of user-selectable sub-zones each having a plurality of user-selectable compression ratios" as recited in claim 9. In the portions of Suzuki cited by the Examiner, a compression ratio is specified for a region of an image, but there is no teaching or suggestion of "displaying a plurality of user-selectable sub-zones each having a plurality of user-selectable compression ratios."

Furthermore, none of Matama, Barker or Suzuki show or describe any instance of a "chrominance and luminance data provided by the computing system". The cited portions of Matama do not show or describe this limitation, and none of Barker or Suzuki cure this deficiency. Assignee is unable to locate any instance in any of Matama, Barker or Suzuki where "chrominance and luminance data provided by the computing system" is described. It is respectfully requested that the Examiner either provide guidance as to where these missing elements may be located, or withdraw this rejection to the pending claims.

Accordingly, any proper combination of Matama, Barker and Suzuki, although, as stated previously, Assignee does not accept that any such combination would be proper, would still not disclose all the elements of the rejected claims, as set forth above. Accordingly, the Examiner has failed to make a successful prima facie showing of obviousness, and it is respectfully submitted that claims 9-11 and 13 are in a condition for allowance.

Additionally, it is respectfully submitted that claim 15 is not rendered obvious by the combination of Matama, Barker, Suzuki and Mikklesen. For example, the cited documents, even if properly combined, would still not teach or suggest all the claim limitations. Mikklesen, directed toward compression portions of an image based on the content of the image, and does not show or describe at least "displaying a plurality of user-selectable sub-zones each having a plurality of user-selectable compression ratios". Accordingly, Mikklesen does not make up for the deficiencies of Matama, Barker and Suzuki in meeting these limitations and any resultant combination of Matama, Barker, Suzuki and

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Mikklesen, even if proper, would still not provide all the elements of the rejected claims, as set forth above. Therefore, Assignee respectfully submits that Examiner has not made out a *prima facie* showing of obviousness, and that claim 15 is in a condition for allowance.

Assignee respectfully submits that because a *prima facie* case of obviousness has not been established, all pending claims are in a condition for allowance. It is noted that many other bases for traversing the rejections could be provided, but Assignee believes that the grounds presented above are sufficient. It is, therefore, respectfully requested that the Examiner withdraw the rejection of these claims, and allow all pending claims to proceed to allowance.

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CONCLUSION

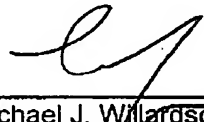
In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application, as amended, are in condition for allowance. If the Examiner has any questions, she is invited to contact the undersigned at (503) 439-6500. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3703.

Respectfully submitted,

Dated: \_\_\_\_\_

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